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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,018	04/25/2006	Shun Yoshiya	522341-0350567 (YIP0048-U)	7525
909 7590 07/09/2009 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER LOPEZ, RICARDO E.	
			ART UNIT 4132	PAPER NUMBER
			MAIL DATE 07/09/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,018	<b>Applicant(s)</b> YOSHIYA, SHUN	
	<b>Examiner</b> RICARDO E. LOPEZ	<b>Art Unit</b> 4132	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/25/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restriction***

1. Applicant's election with traverse of invention Group I, claims 1 and 4, in the reply filed on July 01, 2009 is acknowledged. The traversal is on the ground(s) that a search can be conducted without a serious burden. This is not found persuasive because the method of fabrication the claimed ornament and the ornament are classified under different class / subclass, i.e. 264/15 and 428/7, respectively, which is prima facie evidence that searching and examining both claim groups would constitute a serious burden.
2. The requirement is still deemed proper and is therefore made FINAL.
3. Claims 2, 3 and 5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 01, 2009.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being unpatentable over Kabushiki JP-63-85113.

6. Considering claim 1, Kabushiki teaches in the embodiment of Fig. 1 an ornament bead comprising a pair of insert holes 1 and 2 and an extract hole 3. These three holes extend and communicate each other at the center of the bead. The three holes intersect at 120 degree angle each other, like a Y shape. In the embodiment illustrated in Fig. 2, Kabushiki teaches the use of a grinding tool 5 that can be inserted to each hole to cut off each vertex portion of the included angle formed in the spherical body between the two holes (Abstract). Thus, Kabushiki teaches all limitation in the instant claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kabushiki JP-63-85113 in view of Pratt US 2003/0121150 A1.

9. Considering claim 4, Kabushiki also teaches in the embodiment illustrated in

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Fig. 1 that the ornament comprises a string 12 as a support member for the beads, wherein each end of string 12 is inserted to each hole 2 and both ends are extracted from extract hole 3. Kabushiki does not teach that the support member be a wire. Pratt teaches that necklaces often consist of a multiplicity of beads strung on an elongated slender support, e.g. chain, wire, string, etc. In some cases the beads are arranged in groups spaced apart along the length of the support, with the beads in each group often having different sizes; the stops separating the groups often consist of drops of solder on the wire support that bracket each group [005]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the beads structure of Kabushiki with the wire support element of Pratt in order to fabricate strung ornaments with beads arranged in groups spaced apart by means of solder drops on the wire support.

#### **EXAMINER'S COMMENT**

9. A translation of Kabushiki's reference JP-63-85113 has been ordered from Translations Branch.

#### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICARDO E. LOPEZ whose telephone number is (571)270-1150. The examiner can normally be reached on Monday to Thursday 8:00 am-5:30pm EST, and every other Friday from 8:00 am to 4:30 pm..

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11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lavilla can be reached on (571)272-1539. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/REL/

Ricardo E. Lopez  
Patent Examiner, Art Unit 4132  
July 06, 2009

**/Michael La Villa/  
Michael La Villa  
Supervisory Patent Examiner, Art Unit 4132  
7 July 2009**